

### REMARKS

Claims 36, 38-48, 50-56, 59, 61-63, 64, 69-76 and 78-79 are pending in the present application. Claims 36, 48, 52-53, 55-56, 59, 63, 69-70, and 75 were amended to further describe that which was previously claimed and to maintain antecedent basis, and Claim 77 was canceled. No new matter has been added. Favorable reconsideration and allowance of the present application are respectfully requested in view of the amendments and the following discussion.

#### Commonly Owned Applications

Pursuant to 37 CFR §1.56, Applicant and Applicant's attorney hereby make of record in the above-identified patent application the existence of the below described activities in the below-identified commonly owned co-pending published patent applications. The below-identified co-pending published patent applications were previously identified and cited in an Information Disclosure Statement in the above-identified patent application.

U.S. Patent Publication No. 2003/0065620 A1 – U.S. Patent Application Serial No. 10/264,219 – Office Action mailed March 17, 2008, Response filed May 19, 2008 ;

U.S. Patent Publication No. 2003/0065749 A1 – U.S. Patent Application Serial No. 10/263,566, filed October 3, 2002, – Decision on Appeal – REVERSED March 14, 2008, Notice of Allowance mailed June 12, 2008;

Serial No. 10/751,022  
Amendment and Response to Non-Final Office Action  
Filed: July 1, 2008

Filed: January 2, 2004

### **Information Disclosure Statement**

**THIRD REQUEST** - An Information Disclosure Statement was filed on November 13, 2006, together with a PTO Form 1449 listing the references cited therein. Applicant received an initialed copy of the PTO Form 1449. However, **U.S. Patent No. 7,020,251 was not initialed as having been considered by the Examiner.** Applicant again respectfully requests a copy of the PTO Form 1449 with initials next to U.S. Patent No. 7,020,251 to confirm that U.S. Patent No. 7,020,251 has been considered and made of record in the case.

### **Previously Canceled Claims**

The office action mailed April 2, 2008 refers to a number of cancel claims. For the record, claims 1 and 58 as identified in item 1.2, page 6; claims 1, 37, 3, 14, 15, 26 and 27 as identified in item 1.4, page 7; and claims 57 and 64 as identified in item 3, page 9 have been previously canceled and are no longer pending. Accordingly, Applicant has ignored the portions of the office action referring to canceled claims. Applicant respectfully requests another office action and an opportunity to respond if the above-identified claim numbers are typographical errors and should actually refer to any of the presently pending claims.

### **Claim rejections pursuant to 35 U.S.C. § 103(a)**

Claims 36, 38, 44-45, 46-48, 50, 51, 54, 56, 59, 61-63, 65, 67-70, 73, 75 and 77-79 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over U.S.

Patent No. 6,449,344 to Goldfinger et al. (hereinafter referred to as "Goldfinger"), U.S. Patent Publication No. 20030078034A1 to Tsutsumi et al. (hereinafter referred to as "Tsutsumi"), U.S. Patent No. 6,546,005 to Berkley et al. (hereinafter referred to as "Berkley") and further in view of U.S. Patent Pub. No. 2004/0059790 to Austin-Lane et al (hereinafter referred to as "Austin-Lane"). Also, Claim 40 was rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Goldfinger, in view of Tsutsumi, in view of Berkley, in view of Austin-Lane and further in view of U.S. Patent No. 6,754,665 to Futagami et al. (hereinafter referred to as "Futagami"). Further, Claims 41, 52, and 55 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Goldfinger, in view of Tsutsumi, in view of Berkley, and further in view of U.S. Patent Publication No. 20020055351A1 to Elsey et al. (hereinafter referred to as "Elsey"). In addition, Claims 42 and 53 were rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over Goldfinger, in view of Tsutsumi, in view of Berkley, in view of Austin-Lane and further in view of U.S. Patent No. 6,345,245 to Sugiyama et al. (hereinafter referred to as "Sugiyama"). Also, Claim 72 was rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over Goldfinger, in view of Tsutsumi, in view of Berkley, in view of Austin-Lane and further in view of U.S. Patent Publication No. 20050020250A1 to Chadda et al. (hereinafter referred to as "Chadda"). Finally, Claims 74 and 76 were rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over Goldfinger, in view of Tsutsumi, in view of Berkley, in view of Austin-Lane and further in view of U.S. Patent Publication No. 20040054935 to Holvery et al. (hereinafter referred to

as "Holvery"). Applicant respectfully traverses these rejections since the presently cited combinations of references fail to teach or suggest each and every limitation of the presently pending claims. Thus, a *prima facie* case of obviousness cannot be maintained.

Claims 36, 38-47, and 69-72

Claim 36 has been amended to incorporate the limitations of Claim 77, and Claim 77 has been canceled. On page 8, item 1.8 of the office action mailed April 2, 2008, it was asserted that "It would have been obvious ... that the method and system as modified would teach the feature as claimed." Applicant respectfully traverses this assertion because the cited references have been misconstrued in the present rejection. MPEP §2141 provides that to establish a *prima facie* case of obviousness under 35 U.S.C 103(a) an examiner is required to resolve factual inquiries according to *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). The requirement of resolving these factual inquiries was recently reiterated by the Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, 82 USPQ2d 1385 (2007). Among these factual inquiries, an Examiner must accurately determine the scope and content of the prior art. See MPEP §2141(II.A.). In the present application, the cited prior art has not been accurately determined because limitations in Claim 36 are not taught or suggested by the cited references.

For example, in the rejection of Claim 77, no citation of art has been provided, and the limitation of determining a contact preference in Claim 36 was

rejected in view of Berkley on page 5 of the office action mailed April 2, 2008.

Berkley, however simply describes various phone numbers by which the user may be reached, and very clearly does not teach or suggest accessing permissions of the user of the subscriber terminal with the information assistance application to determine if the contact information request should be automatically denied categorically or specifically, based on the identification of the requestor as described in Claim 36.

Moreover, on page 5 of the office action mailed April 2, 2008, it was apparently asserted that an authorization request that includes an indication of an identity of the requestor based on identification of the requestor from the unique information was obvious in view of the combination of Goldfinger and Berkley. However, Goldfinger is wholly silent regarding an authorization request that includes indication of an identity of a requestor, and instead simply describes transmission of a request for authorization (Col. 6 line 58), and Berkley does not bridge this gap in Goldfinger.

Claim 36 also describes that the response includes only contact information identified by the user of the subscriber terminal as permissible to send to the wireless terminal. On page 4 of the office action mailed April 2, 2008, it was asserted that Tsutsumi described such limitations, however, the cited portions of Tsutsumi simply describes "a list of information (files) stored in the storage part, and attribute information such as transmission permission information" (para [0037]) that "refers to information that indicates whether or not it is permitted to

transmit the information in question to other cellular telephones." (para [0038]) Tsutsumi also includes Fig. 3, which is a diagram showing "the construction of the file titled 'list of stored information,'" which does not include any form of contact information of a user as described in Claim 36. Moreover, Tsutsumi's "list of stored information" is "stored in a root directory" that is "provided beforehand in the storage part 17" of a cellular telephone. (para [0036] and [0037]) Claim 36, on the other hand describes accessing permissions of the subscriber terminal with an information assistance application located on an information assistance server. Thus, Tsutsumi teaches away from the limitations of Claim 36.

Claim 40 describes that the request includes at least one information record item about the subscriber terminal... On page 9 of the office action, it was asserted that "Futagami teaches sharing information stored in a personal information database [Abstract]." Applicant respectfully asserts that Claim 40 describes a request that includes at least one information record item. The cited portions of Futagami, on the other hand, fails to teach or suggest a request that includes at least one information record item. In fact, the limitations of a request that includes at least one information record item has been wholly ignored. Applicant respectfully requests examination on the merits of the whole of Claim 40 pursuant to MPEP 707 and 37 CFR §1.104(b) and 37 CFR §1.104(c).

Claim 41 describes interpreting the contact information request with a voice recognition module when the contact information request is a spoken request. On pages 9 and 10 of the office action, it was asserted that "Else disclose (sic) voice

response unit to process information assistance calls." However, Elsey specifically describes a voice response unit (VRU) to play back constantly repeated parts of an operator's speech and for receiving verbal input from a party connected to the VRU. (paragraph [0051]) Thus, Elsey teaches away from the claimed invention by describing that a party must be "connected" to the VRU. In Claim 41 a request received from a wireless terminal is described. The wireless terminal is not "a party connected to the VRU" as described by Elsey. Moreover, Claim 42 depends from Claim 41, yet Elsey, (which makes a combination of six cited references), is not identified in the obviousness rejection of Claim 42. Applicant respectfully traverses the rejection of Claim 42 since neither Elsey nor Sugiyama teach or suggest interpretation of anything with the combination of a voice recognition module and a natural language processing module as described in Claim 42.

Claim 45 describes accessing a customer proprietary information record having customer contact data that includes a contact preference, the customer proprietary information record associated with the subscriber terminal. On page 7 item 1.5 of the office action, it was apparently asserted that Goldfinger as modified by Berkley rendered obvious such limitations, however, Goldfinger is silent regarding any form of customer proprietary information record, and Berkley describes an active user registry database (AUR) that is associated with a user identified by name and address (Col. 7 lines 8-16), not a subscriber terminal as described in Claim 45. Thus, the combination of Goldfinger and Berkley fails to

teach or suggest a customer proprietary information record associated with a subscriber terminal as described in Claim 45.

Claim 69 describes receiving an indication in the reply of information from among the contact information that is permitted to be provided to the wireless terminal of the requestor. On page 7, item 1.6 of the office action mailed April 2, 2008, it was asserted that such limitations were described by Tsutsumi. Applicant respectfully traverses this rejection since Tsutsumi describes a list that "refers to information that indicates whether or not it is permitted to transmit the information in question to other cellular telephones." As previously discussed, the list as described by Tsutsumi does not include contact information. In addition, neither Tsutsumi or any other of the cited references teach or suggest a reply from a subscriber terminal comprising an indication of information from among the contact information that is permitted to be provided to the wireless terminal of the requestor.

Claim 70 describes accessing a profile associated with a user of the subscriber terminal to determine what portion of information from the contact information is permitted to be provided to the wireless terminal of the requestor. Applicant again respectfully traverses that the combination of Goldfinger and Tsutsumi describe such limitations since neither reference teaches or suggests a profile, or that such a profile can be used to determine what portion of information from the contact information is permitted to be provided to the wireless terminal of the requestor. Goldfinger is wholly unconcerned with permission to provide a portion of contact



information, and Tsutsumi not only fails to describe contact information, but also describes permission related to files, not a portion of information from contact information as described in Claim 70.

Claim 72 describes accessing a database to determine a format of the response that is compatible with the wireless terminal. On page 11, item 5.1 of the office action, it was asserted that Chadda described such limitations. Applicant respectfully traverses this assertion since the cited portion of Chadda simply describes text to speech conversion without any indication of a database, or accessing such a database to determine format. Moreover, Chadda was filed May 24, 2004, which is after the filing date of the present application, and the provisional applications from which Chadda takes priority also do not teach or suggest accessing a database to determine a format of the response that is compatible with the wireless terminal, thus, Chadda is not prior art to the claimed limitation of the present invention.

Claim 75 describes including a response mechanism in the authorization request that enables approval or disapproval of the request for the contact information and indication of information to be provided from the contact information. On page 8, item 1.8 of the office action, it was asserted that such limitations were "obvious to one of ordinary skill in the art" without citation of art supporting such a factual assertion. As made clear in *KSR Int'l Co. v. Teleflex, Inc.*, 82 USPQ2d 1385 (2007) rejections on obviousness grounds cannot be sustained by mere conclusory statements. In the office action, factual conclusions regarding

inclusion of the described response mechanism have been postulated without articulated clear reasons as to why such limitations would be obvious. Simply indicating that such limitations are obvious "because the modified method teaches requesting and response authorization mechanism" and describing limitations from Applicants specification fails to provide such reasons. To the contrary, request and response mechanisms alone fail to provide reasoning regarding the obviousness of a response mechanism included in the request that not only enables approval or disapproval, but also enables indication of information to be provided. Such limitations go well beyond the description of Goldfinger, Berkley or Tsutsumi either alone or in combination.

Claim 76 describes receiving a voice-based request in a natural language format, and converting the voice-based request to text with a voice recognition module to identify words, and a natural language processing module to identify the intent or meaning of the words. On page 12, item 6.2 of the office action, it was assert that Holvery described such limitations. Applicant respectfully traverses these assertions since Holvery describes voice and menu-based telephone instructions functionality with a voice recognition unit (VRU). (see [0024]) Holvery clearly describes that the VRU is operated with menus and thus cannot possibly describe a voice-based request in a natural language format as described in Claim 76.

Claims 48 and 50-56

In addition to the previously discussed reasons, Applicant also respectfully traverses the rejection of Claims 48 and 50-56 at least because Claim 48 has been amended to describe a code segment that interprets a reply from the subscriber terminal to determine if permission to provide the phone number associated with the subscriber terminal to the wireless terminal was granted, and whether the user of the subscriber terminal has specified provision to the wireless terminal of additional contact information of the user of the subscriber terminal, and a code segment that generates a response to the wireless terminal that includes the phone number associated with the subscriber terminal when permission is granted, where the response also includes any additional contact information specified by the user of the subscriber terminal.

None of Goldfinger, Berkley, Tsutsumi, or any other cited reference teaches or suggests determination of whether a reply from a subscriber terminal has specified provision to the wireless terminal of additional contact information of the user of the subscriber terminal, or generation of a response that includes additional contact information specified by a user of a subscriber terminal as described in Claim 48.

Amended Claim 48 also describes a code segment that receives a contact information request message specifically requesting a phone number associated with a subscriber terminal. Goldfinger, on the other hand describes a "list of sought

users." Clearly, a contact information request message specifically requesting a phone number as described in Claim 48, and a list of sought users as described by Goldfinger are entirely different. Moreover, neither Berkley nor Tsutumi provide any teaching or suggestion of such limitations.

Claim 48 also describes a code segment to identify the requestor from unique information included with the contact information request. On page 5 of the office action, it was asserted that "One skilled in the art would also realize that the method as modified would teach claimed identifying the requestor steps." Applicant respectfully asserts that neither Goldfinger nor Berkley teach or suggest any form of processing to identify the requestor from unique information included within the contact information request. Even if such information were available in the systems of Goldfinger and Berkley, there is no teaching or suggestion of using such information to identify a requestor as described in Claim 48.

In addition, no support for such an assertion is provided in the office action mailed April 2, 2008. Applicant respectfully asserts that each and every limitation must be taught or suggested by the cited references. If the rejection is relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art, which has not occurred. MPEP §2112 (citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)).

Claim 48 also describes a code segment that generates an authorization request ...[that]... includes identification of the requestor as identified from the unique information. Neither Goldfinger, nor any other cited reference teaches or suggests an authorization request as described in Claim 48 that includes an indication of the identity of the requestor. Once again, Applicant respectfully traverses the unsupported assertion included in the office action.

Claim 48 also describes a code segment to determine from a database based on the identification of the requestor, a communication preference of the requestor and compatibility settings of the wireless terminal, a code segment that generates a response to the wireless terminal, ... the response generated in accordance with the communication preference and the compatibility settings. On page 6 item 1.2 of the office action it was asserted that independent Claim 48 was "rejected for the same reason as stated above in Claim 1."<sup>1</sup> However, Claim 36 includes no limitations related to compatibility settings, and the rejection of Claim 36 does not address such limitations. Thus, limitations related to the compatibility settings included in Claim 48 have been wholly ignored. Accordingly, Applicant respectfully requests examination on the merits of Claim 48 in accordance with MPEP 707 and 37 CFR §1.104(b) and 37 CFR §1.104(c).

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<sup>1</sup>Applicant has assumed that the references to "Claim 1" are actually references to pending Claim 36 since Claim 1 is no longer pending in this case. If these statements are not meant to refer to Claim 36, Applicant respectfully requests issuance of an office action with the correctly cited Claim(s) and an opportunity to further respond.

Claims 59, 61-65 and 73

In addition to the previously discussed reasons, amended Claim 59 and the claims dependent therefrom are not taught or suggested by the cited references at least because amended Claim 59 describes the information assistance application server operable to run an information assistance application that is configured to generate a webpage comprising input fields configured to receive a contact information request from a wireless terminal operated by a requestor for an information item associated with a subscriber terminal other than the wireless terminal. Goldfinger, on the other hand simply describes that a communications terminal provides a list of sought users predefined by a user, which is maintained by an information management apparatus. (Col. 6 lines 3-5) Neither Goldfinger, nor any other cited reference describes a webpage as described in Claim 59.

Amended Claim 59 also describes that the authorization request includes the name of the requestor, and a selectable option to indicate what information may be provided to the requestor in response to the authorization request. Goldfinger on the other hand, simply describes a request for information. (Col. 6 lines 56-59) Thus, neither Goldfinger, nor any other cited reference describes a selectable option as described in Claim 59.

Claim 78-79

Claim 78 describes accessing a database to determine a user specific contact preference and a user specific message format for the subscriber terminal in response to receipt of the contact information request. Claim 78 also describes transmitting for receipt by the subscriber terminal an authorization request that includes indication of the identified identity of the requestor, the authorization request comprising a multi-modal message that includes both a voice-based request and a text-based request in accordance with the user specific message format. On page 8, item 1.9, it was indicated that Claim 78 was rejected for the same reasons as Claims 36 and 39 were rejected. However, Claims 36 and 39 do not include the limitations of a user specific message format or an authorization request comprising a multi-modal message that includes both a voice-based request and a text-based request in accordance with the user specific message format.

In fact, the office action mailed April 2, 2008 does not assert that the combination of the cited references meet the limitations of a user specific message format for the subscriber terminal or an authorization request as described in Claim 78, but rather simply disregards these limitations completely. Accordingly, it is respectfully requested that the rejection of Claim 78 be withdrawn as improper. (See MPEP 707 and 37 CFR §1.104(b) and 37 CFR §1.104(c))

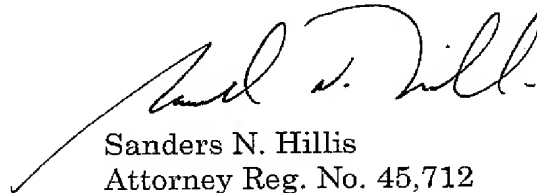
For at least the foregoing reasons, the cited references either alone or in combination fail to teach, suggest, disclose, or render obvious, each and every

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limitation of presently pending Claims 36, 38-48, 50-56, 59, 61-63, 64, 69-76 and 78-79. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejections of these claims. With this amendment and response, the currently pending claims are patentable over the cited references. Thus, Applicant respectfully requests the issuance of a Notice of Allowance for this application. Should the Examiner deem a telephone conference to be beneficial in expediting allowance/examination of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

Respectfully submitted,



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